



3736

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of
Burbank et al.

For: **TISSUE ACQUISITION SYTEM AND
METHOD OF USE**

Serial No.: 09/981,525

Filed: October 16, 2001

Atty.: Docket No.: 9619.1031

) Examiner: Not yet assigned

) Group Art Unit: 3736

) Customer No. 23422

TRANSMITTAL

CERTIFICATE OF MAILING PURSUANT TO 37 CFR § 1.8

I hereby certify that these papers are being deposited with the U.S. Postal Service as first class mail with sufficient postage addressed to
Commissioner for Patents, Office of Petitions, U.S. Patent and Trademark Office, Washington, D.C. 20231,

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Commissioner for Patents
Office of Petitions
U.S. Patent and Trademark Office
Washington, D.C. 20231

TECHNOLOGY CENTER R3700

Dear Sir:

1. Transmitted herewith for filing in the above-identified patent application are

X Petition For Claim Of Priority To Provisional Application and Amendment;
and

X Return receipt postcard.

2. Calculation of Fees

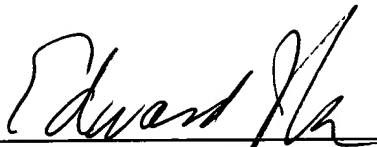
X Petition fee under 37 CFR §1.17: \$130.

3. Payment of Fees

X Enclosed is Check No. 62259 in the total amount of \$130.

X The Commissioner is authorized to charge all fees due and to credit any
overpayment of fees which may be required under 37 C.F.R. §1.16 or

§1.17, to Deposit Account No 13-0201, referencing Atty. Docket No.
9610.1042. **A duplicate copy of this transmittal is enclosed.**

By: 
Edward J. Lynch
Registration No. 24,422

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

10-3-02

#9

In the application of
Burbank et al.

For: **TISSUE ACQUISITION SYSTEM
AND METHOD OF USE**

Serial No.: 09/981,525

Filed: October 16, 2001

Atty. Docket No.: 9619.1031

) Examiner: Not Assigned

) Group Art Unit: 3736

) Confirmation No.: 8046

) Customer No.: 23422

) **PETITION FOR CLAIM OF PRIORITY**
) **TO PROVISIONAL APPLICATION**
) **And AMENDMENT**

CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. §1.8

I hereby certify that this paper is being deposited in the U.S. Postal Service as first class mail with sufficient postage addressed to Commissioner for Patents, Office of Petitions, U.S. Patent and Trademark Office, Washington D.C. 20231, on 9/19/02, in San Francisco, CA.

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TECHNOLOGY CENTER R3700

Commissioner for Patents
Office of Petitions
U.S. Patent and Trademark Office
Washington, D.C. 20231

Dear Sir:

Applicants have received the "DECISION ON PETITION" in this case, which was mailed August 5, 2002. Applicants respectfully submit that the DECISION ON PETITION did not take into account certain pertinent information on file in the case, and thus believe the decision to be in error, for at least the reasons enumerated below.

The DECISION ON PETITION states that: "the reference and claim for priority to Provisional Application No. 60/076,973 (filed on 3 March, 1998) is contained nowhere in the record herein until Petitioner's attempt to amend filed on 11 April, 2002, over a 26 March, 2002, certificate of mailing."

However, applicants respectfully submit that the reference and claim for priority were indeed included with the application at the time of application. The "REQUEST FOR FILING A

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DIVISIONAL APPLICATION UNDER 37 C.F.R. § 1.53(b)” filed October 16, 2001 contains the following:

“This is a request for filing a divisional application under 37 C.F.R. § 1.53(b), of pending prior application Serial No. 09/196,125, filed November 20, 1998, which is a continuation-in-part of application Serial No. 09/057,303, filed April 8, 1998, of Fred Burbank, Paul Lubock, Michael L. Jones, and Martin V. Shabaz, for **TISSUE ACQUISITION SYSTEM AND METHOD OF USE**, which is incorporated herein in its entirety.”

Applicants respectfully note that the parent application, 09/057,303, claims priority to Provisional Application 60/076,973 (filed on 3 March, 1998). The present application claims priority from the parent application, and explicitly incorporates it by reference. The priority claim of the parent application to the provisional application is thus also included in the present application.

Thus, the present application derives priority from Provisional Application No. 60/076,973 (filed on 3 March, 1998), which, being claimed at the time of application, was claimed within four months from the time of application as required by 37 C.F.R. § 1.78

Applicants respectfully submit that the claim to priority is timely filed as being included in the parent application claimed and incorporated by reference at the time of filing. Applicants hereby request that the claim for priority to the provisional patent application 60/076,973, filed March 3, 1998, be recognized for at least the reasons enumerated above.

Accordingly, applicants respectfully submit that the previously filed AMENDMENT to replace the first paragraph with the following paragraph does not add new matter, and request that the amendment, denied by the DECISION ON PETITION, be entered so that the first

paragraph of the present application is replaced by the following paragraph:

This application is a divisional of copending patent application Serial No. 09/196,125, filed November 20, 1998, which is a continuation-in-part of patent application Serial No. 09/057,303, filed April 8, 1998, now U.S. Patent No. 6,331,166, which claims benefit to provisional patent application Serial No. 60/076,973, filed March 3, 1998, all of which applications are hereby incorporated herein by reference in their entirety and from which priority is hereby claimed under 35 U.S.C. §§119(e) and 120.

CONCLUSION

Applicants respectfully request that the present application be afforded the benefit of Provisional Application No. 60//076,973 and of its filing date of March 3, 1998; and that the first paragraph of the present application be replaced by the proposed amended paragraph above.

Respectfully submitted,

By: 

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MARKED-UP COPY OF THE CHANGES MADE

(Additions are underlined and deletions [bracketed].)

This application is a divisional of copending patent application Serial No. 09/196,125, filed November 20, 1998, which is a continuation-in-part of patent application Serial No. 09/057,303, filed April 8, 1998, now U.S. Patent No. 6,331,166, which claims benefit to provisional patent application Serial No. 60/076,973, filed March 3, 1998, all of which applications are hereby incorporated herein by reference in their entirety and from which priority is hereby claimed under 35 U.S.C. §§119(e) and 120.